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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/368,792 | 08/05/1999 | SANDRA L. STANDIFORD | 10981001-1 | 5929 |

22879 7590 12/16/2003

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EXAMINER

TRAN, THAI Q

ART UNIT PAPER NUMBER

2615

DATE MAILED: 12/16/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/368,792

Applicant(s)

STANDIFORD ET AL.

Examiner

Thai Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 September 2003 and 22 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 August 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) g.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed Sept. 16, 2003 have been fully considered but they are not persuasive.

In re pages 6-7, applicants argue that no valid suggestion has been made as to why a combination of Dunlap and Yamamoto is desirable because it is well settled that the fact that references can be combined or modified is not sufficient to establish a prima facie case of obviousness, M.P.E.P. § 2143.01. Using a digital converter will not affect the quality of the video signal that is to be duplicated. In other words the video signal is not changed by adding a digital converter. Moreover, in comparing the analog signal with the converted digital signal, by definition, the converted digital signal has less information than the analog signal, and thus the digital signal is of less quality than the analog signal. Furthermore, applicants believe that Dunlap will not benefit from the teachings of Yamamoto. Yamamoto is addressing tape degradation that occurs in mass production of tapes. Over time, a master tape will degrade from being replayed at high speed for many times, see column 1, lines 54-63 of Yamamoto. Dunlap is directed to a consumer electronic device, and thus does not involve the mass production of tapes using high speed duplication. Thus, Dunlap will not experience the problems that are solved by Yamamoto, and consequently, there is no desirability to incorporate Yamamoto into Dunlap. The language of the stated motivation is then merely a statement that the reference can be modified, and does not state any desirability for making the modification. The mere fact that references can be combined or modified

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does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 USPQ.2d 1430 (Fed. Cir. 1990), as cited in M.P.E.P. § 2143.01. Thus, the motivation provided by the Examiner is improper, as the motivation must establish the desirability for making the modification. Therefore, the rejection of claims 1-6, 9-11, and 14-19 should be withdrawn.

In response, the examiner respectfully disagrees. The examiner has pointed out what each of the prior art references teaches and has indicated how and why these references would have been combined to arrive at the claimed invention. Applicants cannot show non-obviousness by attacking the references individually where, as here, the rejection is based on a combination of references. In re Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Dunlap discloses the capability of dubbing video signal from one tape to another tape (see col. 3, lines 38-48 and col. 4, lines 46-64). Yamamoto et al discloses in col. 1, lines 54-63 that

“With such a duplicator as described above, however, the quality of the slave tapes which are ultimately obtained depends on the quality of signals played back from the source tape. The source tape, in particular, the print mother tape is driven at high speed and used a number of times, so that it may often be **damaged or broken to degrade its recorded contents, resulting in deterioration of the quality of the slave tapes**; therefor, it is necessary to keep a reserve of such expensive print mother tape” and from col. 1, line 67 to col. 2, line 5 that

“Accordingly, a primary object of this invention is to provide a duplicator and a duplicating method which are free **from the abovesaid defect of the prior art** and according to which analog signals recorded on a source tape are transferred to digital discs after conversion into digital form and the digital signals are then transferred to slave tapes after reversion into analog form”.

From the above passages, it is clear that Yamamoto et al teaches **an advantage of increase the quality of the video signal to be duplicated by** transferring the video signal from the source tape to digital discs after conversion into digital form and the digital signals are then transferred to slave tapes after reconversion into analog form. The motivation for combining the references is clearly taught in Yamamoto et al and it is desirable to combine Dunlap and Yamamoto as proposed by the examiner for the advantage of increase the quality of the video signal to be duplicated as taught by Yamamoto et al.

Additionally, additional motivations for combining Dunlap and Yamamoto et al are also taught in col. 2, lines 6-30 of Yamamoto et al.

In re pages 7-8, applicants argue that the combination of Dunlap and Yamamoto et al does not disclose the **newly added limitation “a key frame marker for inserting at least one marker into the digital data”**.

In response, it is agreed that the combination of Dunlap and Yamamoto et al does not disclose the limitation “a key frame marker for inserting at least one marker into the digital data”. However, such limitation is taught in col. 7, lines 20-59 (adding pointers to the digital signal) of Tognazzini (US 6,263,147B1).

In re pages 8-9, applicants argue that the rejection of claims 7-8, 12-13, and 20 should be withdrawn because the motivation used in the rejection of claims 1, 10, and 19 is deficient as discussed above.

In response, as discussed above, the motivation to combine Dunlap and Yamamoto et al is taught in Yamamoto et al.

In re page 9, applicants state that the combination of Dunlap and Yamamoto et al does not disclose the claimed limitation as discussed above.

In response, as discussed above, the **newly added limitation “a key frame marker for inserting at least one marker into the digital data”** is taught in col. 7, lines 20-59 (adding pointers to the digital signal) of Tognazzini (US 6,263,147B1).

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 10-11 and 14-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dunlap et al ('552) in view of Yamamoto et al ('338) as set forth in the last Office Action.

Regarding claim 10, Dunlap et al discloses a dual decks VCR (Fig. 1), the apparatus comprising:

an analog video cassette player (VCR1 of Fig. 3, col. 4, lines 12-20) for producing analog video output; an analog video cassette recorder (VCR2 of Fig. 3, col. 4, lines 35-45) for storing the video signal outputted from an analog video cassette player in a non-volatile storage medium thereby protecting said data against degradation over time; and wherein the analog video cassette player and an analog video cassette recorder are disposed within a single container. However, Dunlap et al does not specifically disclose an analog to digital converter for converting said analog video output into digital and at least one recorder employing a digital storage medium.

Yamamoto et al teaches a duplicator having A-D converter for converting the video signal output from analog source tape reproducing device (col. 2, lines 64-68) and a least digital disc recorder for recording the output of the A-D converter (col. 2, line 68 to col. 3, line 6) so that the quality of the signal to be duplicated can be increase (col. 1, line 54 to col. 2, line 5).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the A-D converter 9 and the disc recorder 13 as taught by Yamamoto et al into Dunlap et al's system in order to increase the quality of the video signal to be duplicated.

Regarding claim 11, Yamamoto et al also teaches the claimed determining a required digital storage format prior to said step of converting based upon detection of a format of an inserted storage medium (col. 2, line 64 to col. 3, line 6).

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Regarding claim 14, the combination of Dunlap et al and Yamamoto et al does not specifically disclose a CD-R or a CD-RW. It is noted that CD-R and CD-RW are well known and old in the art and therefore Official Notice is taken.

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the well known CD-R or a CD-RW since it merely amount to selecting an alternative equivalent digital disc recorder.

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10/2/03
Regarding claim 15, the combination of Dunlap et al and Yamamoto et al does not specifically disclose a recordable DVD. It is noted that the recordable DVD is well known and old in the art and therefore Official Notice is taken.

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the well known recordable DVD into the combination of Dunlap et al and Yamamoto since it merely amount to selecting an alternative equivalent digital disc recorder.

Regarding claim 16, the combination of Dunlap et al and Yamamoto et al does not specifically disclose wherein the digital storage medium is digital tape. It is noted that digital tape recorder is also well known and old in the art and therefore Official Notice is taken.

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the well known digital tape recorder into the combination of Dunlap et al and Yamamoto since it merely amount to selecting an alternative equivalent video cassette recorder.

Regarding claim 17, Dunlap et al also discloses the claimed wherein the video cassette player employs a VHS format (col. 4, lines 16-20).

Regarding claim 18, the combination of Dunlap et al and Yamamoto et al does not specifically disclose wherein the video cassette player employs the 8 mm format. It is noted that the 8 mm video cassette player is well known and old in the art and therefore Official Notice is taken.

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the well known 8mm video cassette player into the combination of Dunlap et al and Yamamoto since it merely amount to selecting an alternative equivalent video cassette recorder.

Claim 19 is rejected for the same reasons as discussed in claims 10 and 14-15 above.

4. Claims 1-9, 12-13, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dunlap et al ('552) in view of Yamamoto et al ('338) as applied to claims 10 and 19 above, and further in view of Tognazzini ('147 B1) as set forth in the last Office Action.

Regarding claim 1, the combination of Dunlap et al and Yamamoto et al discloses all the features of the instant invention as discussed in claim 10 above except for providing the newly added limitation "a key frame marker for inserting at least one marker into the digital data".

Tognazzini teaches a delayed decision recording device having a key frame marker (col. 6, lines 8-25 and col. 7, lines 20-59) for inserting at least one marker into

the digital data so that the video program can be captured from the beginning even though the decision to capture the video signal is delayed until after the program material has started (col. 1, lines 43-54).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the delayed decision recording device as taught by Tognazzini into the combination of Dunlap et al and Yamamoto et al in order to allow the user to capture the video program from the beginning even though the decision to capture the information is delayed until after the program material has started.

Regarding claim 2, Dunlap et al further discloses a video port for receiving analog video information from an external source (22 and 24 f Fig. 3, col. 4, lines 24-28).

Regarding claim 3, Dunlap et al also discloses the claimed wherein the video cassette player employs a VHS format (col. 4, lines 16-20).

Regarding claim 4, the combination of Dunlap et al and Yamamoto et al does not specifically disclose a CD-R or a CD-RW. It is noted that CD-R and CD-RW are well known and old in the art and therefore Official Notice is taken.

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the well known CD-R or a CD-RW since it merely amount to selecting an alternative equivalent digital disc recorder.

Regarding claim 5, the combination of Dunlap et al and Yamamoto et al does not specifically disclose a recordable DVD. It is noted that the recordable DVD is well known and old in the art and therefore Official Notice is taken.

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the well known recordable DVD into the combination of Dunlap et al and Yamamoto since it merely amount to selecting an alternative equivalent digital disc recorder.

Regarding claim 6, Dunlap et al teaches that the recording medium is selectable by the user (VCR2, col. 4, lines 12-45).

Regarding claim 7, Tognazzini also teaches the claimed wherein the key frame marker (col. 6, lines 8-25) marks abrupt changes in video image sequences, thereby enabling a user to readily locate a beginning and an end of a particular video sequence.

Regarding claim 8, Tognazzini also teaches wherein the key frame marker marks positions in a sequence of said digital data at selectable time intervals (col. 6, lines 8-25).

Regarding claim 9, the combination of Dunlap et al, Yamamoto et al, and Tognazzini does not specifically disclose wherein the video cassette player employs the 8 mm format. It is noted that the 8 mm video cassette player is well known and old in the art and therefore Official Notice is taken.

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the well known 8mm video cassette player into the combination of Dunlap et al and Yamamoto since it merely amount to selecting an alternative equivalent video cassette recorder.

Regarding claim 12, Tognazzini teaches the claimed inserting at least one marker in said digital video data to identify abrupt changes in video scenery, thereby

enabling a user to readily identify particular video sequences during playing of said digital video data (col. 6, lines 8-25).

Regarding claim 13, Tognazzini discloses the claimed inserting at least one marker in said digital video data at selectable time intervals, thereby enabling a user to readily move to selected chronological points in a video sequence during playing of said digital video data (col. 6, lines 8-25).

Regarding claim 20, Tognazzini discloses the claimed a key frame marker for inserting index markers in said digital data marking abrupt changes in video image sequences, and alternatively, at selectable time intervals (col. 6, lines 8-25).

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thai Tran whose telephone number is (703) 305-4725.

The examiner can normally be reached on Mon. to Friday, 8:00 AM to 5:30 PM.

The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

TTQ


THAI TRAN
PRIMARY EXAMINER